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10/728,422	12/05/2003	Joseph W. Cole	112300-3391	9411
29159	7590	04/18/2008		
BELL, BOYD & LLOYD LLP			EXAMINER	
P.O. Box 1135			MOSSER, ROBERT E	
CHICAGO, IL 60690				
			ART UNIT	PAPER NUMBER
			3714	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary

Application No.

10/728,422

Applicant(s)

COLE ET AL.

Examiner

ROBERT MOSSER

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date 12-14-07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Information Disclosure Statement

The Information Disclosure Statement submitted December 14th, 2007 has been reviewed. A copy of said statement including the Examiner's notations has been attached for the Applicant's records.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-4, 9-10, 21-25, and 29-31** are rejected under 35 U.S.C. 102(b) as being anticipated by Marnell (US 5,393,057).

Claims **1-4, and 21-25**: Marnell teaches a method of playing a game including:

accepting a wager (Col 4:10-30);

presenting a main game of video poker including the generation and display of a set of cards representing a player hand (Figure 3);

receiving from the player an input subsequent from the placement of the wager to cause the play of a bonus game wherein said player input is independent of whether a the winning hand corresponds to a plurality of bonus categories (Col 4:30-40);

determining the outcome of the main game through the comparison of the player hand to a set of predetermined winning hands (Col 4:40-56);

awarding a winning amount if the player hand matches a predetermined winning hand(Col 4:40-56);

determining if the winning hand corresponds to a predetermined category of bonus event hands (Col 5:61-6:13);

incrementing the predetermined category of bonus event hands resultant of a match between the winning player hand and the predetermined category of bonus event hands(Col 5:61-6:13, 9:20-41);

playing the bonus event concurrently with the play of the main game wherein based on the random selection of winning hands across a plurality of categories of said bonus event a bonus is awarded reflective of the categories randomly selected(Col 10:7-24); and

resetting the values associated with the bonus categories resultant of awarding a bonus prize (Col 10:17-23).

Claims **9-10, 29-31**: Marnell teaches a method of playing a game including:

restricting play to a base game when said wager is below a threshold and allowing play of the bonus game when the wager is above a threshold (Col 5:37-50); and

funding the bonus award from a portion of the player wagers in a progressive prize system (Col 4:63-5:7) wherein the percentage of the progressive prize awarded to the respective players is based on their score (Col 10:14-23).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **5-8, 15-18, 26-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell (US 5,393,057) as applied to at least claims **1-4** above, and further in view of Bennett (US 6,419,579).

Marnell teaches a method of playing a game as set forth above however is silent regarding the utilization of two dice to determine a multiplier utilized in combination with a bonus winning to determine an additional payout amount or equivalently described as a score. In a related invention however, Bennett teaches the utilization of dice feature including the incorporation of 2 dice in a card game to determine a supplemental payout amount (*Bennett* Figure 2; Col 1:51-2:44). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the utilization of dice to determine a supplemental prize multiplier as taught by Bennett into the invention of

Marnell in order to maintain a player interest in a gaming machine as taught by Bennett (*Bennett* Col 5-15).

Claims **11-14, 19-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell (US 5,393,057).

Claim **11**: Marnell teaches a method of playing a game as set forth above including the use of wild cards in the base game and combinations based thereon in the bonus game (Col 8:62-64) however is silent regarding the specific utilization of a wild category symbol that represents the collective appearance of this symbol rather than accounting for relevant symbol combinations however the characterization of additional categories as wild categories representing the combinations for the remaining categories would have been an obvious to one of ordinary skill in the art at the time of invention because such a combination of wild symbols and symbol categories would have represented the use of known gaming features combined in conventional manners to yield predictable results.

Claims **12-14**: The respective limitations of these claims are presented and redressed above under the redress of at least claims **1-4** presented above.

Claims **19-20**: The respective limitations of these claims are presented and redressed above under the redress of at least claims **9-10** presented above.

Response to Arguments

Applicant's arguments filed 12/14/2007 have been fully considered but they are not persuasive.

The Applicant argues claim 1 with respect to amendment directed to requiring a player input after the placement of a wager as a potential separation between the prior art of Marnell and the claimed invention. Upon review of the Marnell reference however, Marnell teaches a player input portion of the primary game causing the play of the bonus game after the placement of a wager as a Discard/Keep feature (cited above). As this feature qualifies as a player input and in addition thereto causes the participation in the bonus game through effecting the game outcome it meets the claim limitation as presented.

On a related point the Applicant argues the additional claim limitation of "...wherein said input is independent of whether the winning hand corresponds to any of the plurality of predetermined bonus criteria." as providing a proposed secondary point of separation between the claimed invention and the prior art. Upon review of the Marnell reference however, Marnell teaches that the Discard/Keep feature is independent of the whether or not the winning hand corresponds to any of the bonus criteria. Specifically the Discard/Keep feature constitutes both a player input placed after the placement of a wager, and an input which is not reliant on the outcome of the hand.

The applicant additionally argues that Marnell does not provide for the random selection of bonus categories however as previously cited Marnell does teach and provide for both the random selection of cards comprising the player hand and hence

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grid locations (under the embodiment wherein bingo grids filled in correspond to the actual player hands achieved) and in addition thereto a random fill process wherein a responsive to the attainment of a predefined hand a random grid location is selected for completion (Abstract). Under the present interpretation the claimed bonus categories correspond to the individual symbol positions that as set forth by the prior art may be randomly selected responsive to a winning hand and would yield a winning value if the position were to complete a traditional bingo pattern.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714
/R. M./
Examiner, Art Unit 3714